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09/492,133	01/27/2000	Robert Pollin	25541.010600	9478

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EXAMINER

KALINOWSKI, ALEXANDER G

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 01/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/492,133

Applicant(s)

POLLIN, ROBERT

Examiner

Alexander Kalinowski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 27-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 27-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 12, 15.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 27-50 are presented for examination. Applicant filed an amendment on 7/12/2002 canceling claim 26 and adding new claims 27-50. New grounds of rejection of claims 27-50 are established in the instant office action as set forth in detail below. The new grounds of rejection were necessitated by Applicant's amendment. Since the new grounds of rejection were necessitated by Applicant's amendment, the grounds of rejection of claims 27-50 are a final rejection of the claims.

#### ***Response to Amendment***

2. The supplemental declaration under 37 CFR 1.132 filed on 12/29/2003 is sufficient to overcome the rejection of claim 26 based upon the Autopay reference.

#### ***Response to Arguments***

3. Applicant's arguments with respect to claims 27-50 have been considered but are moot in view of the new ground(s) of rejection.

4. The Examiner acknowledges Applicant's response to the Rule 105 request for information.

#### ***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 27-34 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

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The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, the instant claims fail to recite the use of any type of technology (e.g. computer system) within the recited steps of the claimed method of generating payments from accounts of payers to payees. The recited steps constitute an idea on how to generate payments.

Mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case the claimed method recites steps for creating a managing insurance policy backed securities.

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Although the claimed invention produces a useful, concrete and tangible result, since the claimed invention as a whole is not within the technological arts, as explained above, claims 27-34 are deemed to be directed to non statutory subject matter.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 27-50 are rejected under 35 U.S.C. 102(e) as being anticipated by Kight et al., Pat. No. 5,383,113 (hereinafter Kight)

As to claims 27, 35, and 43, Kight discloses a method for generating payments from accounts of payers to payees (see abstract), the method comprising: receiving information requesting a payment including information identifying an amount of the payment to be applied to an account (col. 2 ,lines 45-49 and col. 3, lines 55-59), and information identifying an institution authorized to generate the payment from the account (col. 3, lines 1-14 and 30-54);

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validating the information identifying the institution by comparing it to authenticated information, wherein the information identifying the institution is validated when it corresponds to the authenticated information, and an error indication is generated when it does not correspond to the authenticated information (col. 3, lines 1-14, col. 4, lines 29-35 and lines 43-49); and  
generating a request that the identified institution generate the payment of the identified amount from the account (col. 4, lines 49-52).

As to claims 28, 36, and 44, Kight discloses the method wherein said receiving information further comprises:  
receiving information for identifying a new payer who has not previously been identified, including information identifying the payer and information identifying the account (col. 2, lines 40-49).

As to claims 29, 37, and 45, Kight discloses The method wherein said receiving information further comprises:  
receiving information for identifying a payer who has previously been identified, including information for verifying the identity of the payer (col. 3, lines 15-20).

As to claims 30, 38, and 46, Kight discloses The method wherein said generating the request further comprises:

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printing a check requesting payment of the identified amount by the identified institution (col. 4, lines 53-59 and col. 5, lines 53-65); and

sending the check to the identified institution (col. 4, lines 53-59 and col. 5, lines 53-65).

As to claims 31, 39, and 47, Kight discloses The method wherein said generating the request further comprises:

sending the request for payment of the identified amount by the identified institution to a remote location using a data transfer connection (Fig. 1 and col. 3, line 55 – col. 4, line 3).

As to claims 32, 40, and 48, Kight discloses The method wherein said generating the request further comprises:

printing a check at the remote location requesting payment by the identified institution of the identified amount (Fig. 1, col. 4, lines 53-59 and col. 5, lines 53-65);; and  
sending the check to the identified institution (col. 4, lines 53-59 and col. 5, lines 53-65);.

As to claims 33, 41, and 49, Kight discloses The method wherein said method further comprises: sending the request for payment of the identified amount to the identified institution using a data transfer connection.

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As to claims 34, 42, and 50, Kight discloses The method wherein said method further comprises: receiving information from the identified institution indicating whether sufficient funds are available to generate the payment of the identified amount.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. "Citicorp. To Expand Bill-Paying by Phone Series: 2" discloses bill paying by telephone.
- b. "Electronic Bill Payment ..." discloses electronic bill payment systems.
- c. "Checkfree: The Good, the Bad and the Zealots" discloses electronic bill payment.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any



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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Kalinowski, whose telephone number is (703) 305-2398. The examiner can normally be reached on Monday to Thursday from 9:00 AM to 6:30 PM. In addition, the examiner can be reached on alternate Fridays.

If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached on (703) 305-9588. The fax telephone number for this group is (703) 305-7687 (for official communications including After Final communications labeled "Box AF").

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th Floor, receptionist.

A handwritten signature in black ink, appearing to read "Alexander Kalinowski", with a large, stylized loop at the end.

Alexander Kalinowski

Primary Examiner

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1/12/04